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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,244	07/09/2001	Gabriel Raviv	29888/36772A	8384
4743 7590 08/21/2007 MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/901,244

Applicant(s)

RAVIV ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 60-64 and 66-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 60-64 and 66-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 60 – 64 and 66 – 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 60, the preamble states, “an ear probe tip for a probe which can be inserted into an ear canal comprising”. However, the body of the claim recites limitations related to the structure of the probe. It is unclear whether Applicant is attempting to claim the combination of an ear probe tip and a probe or merely the subcombination of an ear probe tip. If Applicant is attempting to claim the combination, the Examiner suggests modifying the preamble to recite “An apparatus for use in an ear canal” or some other language that clearly defines the desirability of a combination probe/ear probe tip.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 60 – 64 and 66 - 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Baum ('038). Baum teaches an ear probe tip including a body portion **11** having a first end and a second end; a passage **20** formed in the body portion including a surface extending from a first opening at the first end to a second opening at the second end; an outer surface of the body portion; and a

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plurality of annular flanges 41,42,43 extending substantially perpendicular from the outer surface.

Each of the plurality of annular flanges has a substantially circular shape and a diameter, where the diameter of adjacent flanges decreases in size from the first end toward the second end (see Fig. 1).

A flange closest to the second opening is offset from the second end. The passage has a cylindrical shape. The body portion has a frusto-conical shape (see Fig. 1). The plurality of annular flanges are disposed proximate to the middle portion of the body portion. The first opening includes a chamfer (see Fig. 4). The passage has an increased diameter portion 22 adjacent the first opening and an incrementally decreasing diameter from the first end toward the second end. A ring 21 is formed on the outer surface adjacent the first end and the outer surface has an incrementally decreasing diameter from the first end toward the second end 31,32,33. The first end includes a surface configured to engage a base portion of the probe.

5. The claims of the instant application effectively claim the subcombination of an ear probe tip that is intended to be used with a probe having a tube portion with an outer surface, the tube portion beginning at a probe base and terminating at a probe end thereby defining a length of the tube portion to be covered by the probe tip. In order to meet the limitations of the claims, a prior art reference must merely be capable of receiving an appropriately sized probe in the passage through the body portion so that the passage is substantially in contact with the probe along the length to be covered, so that the second opening is proximate the probe end, and so that the second end extends past the probe end a distance sufficient to prevent the probe from contacting the patient's ear yet insufficient to form a portion of the acoustic path from the probe end into the patient's ear canal. The probe tip of Baum meets all of the structural limitations of the claims and is capable of performing the aforementioned intended uses with a probe having appropriate dimensions.

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6. Claims 60 – 64, 68, 71 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,653,239 to Pompei et al.

In regard to claims 60 – 64, 68, 71 and 72, Pompei et al. teaches an ear probe tip (26) including a body portion having a first end and a second end; a passage formed in the body portion including a surface extending from a first opening at the first end to a second opening at the second end (Col. 6, lines 10 – 12); an outer surface of the body portion; and a plurality of annular flanges (27) extending substantially perpendicular from the outer surface. Each of the plurality of annular flanges has a substantially circular shape and a diameter, where the diameter of adjacent flanges decreases in size from the first end toward the second end (Figure 3b). A flange closest to the second opening is offset from the second end. The passage has a cylindrical shape. The body portion has a frusto-conical shape. The plurality of annular flanges are disposed proximate to the middle portion of the body portion. A ring (27) is formed on the outer surface adjacent the first end and the outer surface has an incrementally decreasing diameter from the first end toward the second end. The first end includes a surface configured to engage a base portion of the probe.

The claims of the instant application effectively claim the subcombination of an ear probe tip that is intended to be used with a probe having a tube portion with an outer surface, the tube portion beginning at a probe base and terminating at a probe end thereby defining a length of the tube portion to be covered by the probe tip. In order to meet the limitations of the claims, a prior art reference must merely be capable of receiving an appropriately sized probe in the passage through the body portion so that the passage is substantially in contact with the probe along the length to be covered, so that the second opening is proximate the probe end, and so that the second end extends past the probe end a distance sufficient to prevent the probe from contacting the patient's ear yet insufficient to form a portion of the acoustic path from the probe end into the

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patient's ear canal. The probe tip of Baum meets all of the structural limitations of the claims and is capable of performing the aforementioned intended uses with a probe having appropriate dimensions.

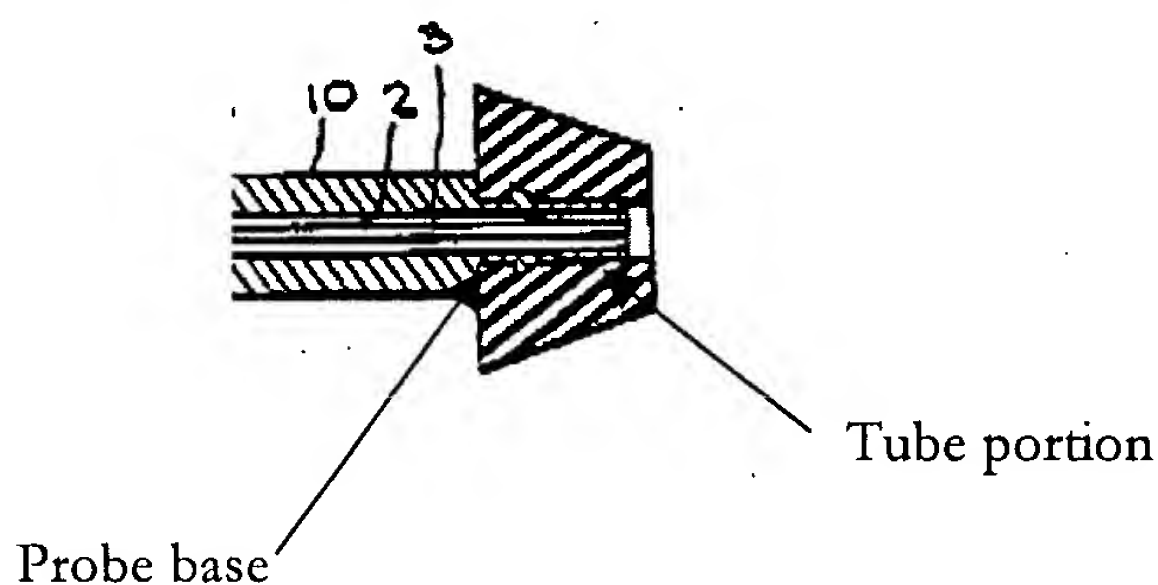
Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 60-64 and 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerouac ('051) in view of Baum ('038).

Kerouac teaches an ear probe tip 12 for use with a probe having a tube portion with an outer surface, the tube portion beginning at a probe base and terminating at a probe end thereby defining a length of the tube portion to be covered by the probe tip.



The ear probe tip 12 includes a body portion having a first end and a second end; a passage formed in the body portion including a surface extending from a first opening at the first end to a second opening at the second end; and an outer surface of the body portion. The passage has a

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cylindrical shape and is configured to be disposed about the probe such that the passage surface is substantially in contact with the probe along the length to be covered and so that the second opening is proximate the probe end. The body portion has a frusto-conical shape with a first end having a surface configured to engage a base portion of the probe. The second end of the probe tip extends past the probe end a distance sufficient to prevent the probe from contacting the patient's ear yet insufficient to form a portion of the acoustic path from the probe end into the patient's ear canal. Kerouac teaches all of the limitations of the claims except that the outer surface of the body portion includes a plurality of annular flanges extending substantially perpendicular from the outer surface and wherein the flange closest the second opening is offset from the second end.

Baum, as discussed hereinabove, teaches that it is known in the art to provide the outer surface of an ear probe tip with a plurality of annular flanges 41,42,43 extending substantially perpendicular from the outer surface and wherein the flange closest the second opening is offset from the second end which will engage and become wedged against the surrounding surface portions of the outer ear cavity in order to automatically establish an acoustic seal therewith (col. 4, lines 4-17).

It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to provide the outer surface of an ear probe tip similar to that of Kerouac with a plurality of annular flanges in view of the teachings of Baum in order to automatically provide an acoustic seal with the outer ear cavity that prevents propagation of sound through the space of the ear cavity surrounding the exterior of the ear probe tip.

Response to Arguments

10. Applicant's arguments filed 6/1/07 have been fully considered but they are not persuasive. Because claim 60 is directed to "an ear probe tip for a probe...", the limitations related to the probe

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are considered by the Examiner as an intended use for the ear probe tip in that the prior art ear probe tips could be used with a probe as suggested in the claims. A recitation with respect to the manner in which an apparatus is intended to be employed does not impose any structural limitation upon the claimed apparatus that differentiates it from a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1947); *In re Yanush*, 477 F.2d 958, 177 USPQ 705 (CCPA 1973); *In re Finsterwalder*, 436 F.2d 1028, 168 USPQ 530 (CCPA 1971); *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963); *Ex parte Masham*, 2 USPQ2d 1647 (BbPatApp & Inter 1987). The ear probe tips disclosed by the prior art meet the limitations in the claims related to the ear probe tip and therefore anticipate or render obvious the claimed invention.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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